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| OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850 | | | EXAMINER GETANEH, MESFIN S | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/647,208

Applicant(s)

WATANABE ET AL.

Examiner

Mesfin Getaneh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 2,4,8,10, and 14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "another first image forming member" in line 2. It is unclear whether this is intended to be the same or different from the "first image forming member" recited in claim 1. If the "another first image forming member" is different than the "first image forming member", it should be disclosed as second, third ...etc image forming member. The "another first image forming member" is interpreted as being the same as the "first image forming member" for this office action.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. **Claim 17** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17 as recited is not patent eligible. See MPEP 2106.01 (I). Specifically, "A program making a computer execute a process" does not fall within a statutory category of a machine, an article of manufacture, a composition of matter, or a process because it is not clear whether a "program" as recited is for causing the computer to execute it as claimed. It could very well imply manual operation of turning on a computer to perform a process. The claim could be remedied by reciting in the preamble "a computer (software) program encoded in a computer-readable medium when executed by the computer comprising:"

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 1-17** are rejected under 35 U.S.C. 102(e) as being anticipated by Teraura (Pub US 20020170973).

With regards to **claim 1**, Teraura discloses an image forming system (copy machine with a facsimile function in FIG. 2) comprising: a first image forming member

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having a data storage unit (printing paper 13 of FIG. 3); and an image forming apparatus for forming an image on at least the first image forming member (FIG. 2), wherein: the image forming apparatus includes: an image reading unit for reading images, which are printed on originals, respectively, to form image data each indicating the read images (a scanner 6 of FIG. 2 reads an image on the sheet of document paper **[0068]** and **[0069]**); an image forming unit for forming the read images on the single first image forming member (printing unit 11 in FIG. 5 prints image on a printing paper with RFID tag **[0081]**); and a data writing unit for writing the image data indicating the images formed on the single first image forming member into the first image forming member (The reader-writer for recording data from the RFID data in RFID tag 14 of the printing paper **[0071]**); and the data storage unit stores the written image data **[0082]**.

With regards to **claim 2**, which further limits claim 1, further comprising: another first image forming member (sheet of document printing paper 13); and a second image forming member (printing paper 13 of FIG. 3), wherein: the first image forming member further includes a data supply unit for supplying the stored image data to an external (first printing paper with RFID tag **[0017]**); the image forming apparatus further includes a data reading unit for reading the image data supplied from the data supply unit (the reader writer as explained in claim1 also performs these tasks **[0017]** and **[0071]**); and the image forming unit utilizes the image data read by the data reading unit to form the image corresponding to the image data on one of the another first image forming member and the single second image forming member (printing unit 11 in FIG. 5 **[0092]**).

With regards to **claim 3**, the apparatus in claim 2 is the same apparatus as claim 1 (see the explanation given to claim 1 apparatus). An image forming apparatus comprising: an image reading unit for reading images, which are printed on originals, respectively, to form image data each indicating the read images; an image forming unit for forming the read images on a single first image forming member; and a data writing unit for writing the image data indicating the images formed on the single first image forming member into the first image forming member.

With regards to **claim 4**, which further limits claim 3, comprising: a data reading unit for reading the image data from the first image forming member (RFID data reading means [0027]), wherein: the image forming unit utilizes the image data read by the data reading unit to form the image corresponding to the image data on one of another first image forming member and a single second image forming member (printing unit 11 as described in [0086] and [0088]).

With regards to **claim 5**, which further limits claim 4, comprising: a display unit for displaying at least one image using the image data read by the data reading unit (liquid crystal display (LCD) unit 35 in FIG. 5).

With regards to **claim 6**, which further limits claim 4, wherein the image data read by the data reading unit is plural pieces of image data (characters, figures, and photo images are plural piece of image data that can be read by the data reading unit [0111]), the image forming apparatus further comprising: a selecting unit for receiving an operation to select at least one of the plural pieces of image data (the control circuit 29 in FIG. 5), wherein: the image forming unit forms the image corresponding to the

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selected image data on the one of the single first image forming member and a single second image forming member (printing unit 11 as described in [0086] and [0088]).

With regards to **claim 7**, an image forming apparatus comprising: an image reading unit for reading images, which are printed on originals, respectively, to form image data each indicating the read images; an image forming unit for forming the read images on a single first image forming member; and a data writing unit for writing layout data indicating positions where the images formed on the single first image forming member are displayed into the first image forming member (the same system as claim 1 wherein a data writing unit is used for writing layout data indicating positions. But the data writing unit of claim 1 also has the inherent capability of recording all the data from original paper to printing paper within a specified position. For example, if the original has A3 size paper and the user wants to print it in A4 size paper, the data writing has the inherent capability of having all the data from the A3 size paper fit in to the A4 size paper [0083]).

With regards to **claim 8**, which further limits claim 7, comprising: a data reading unit for reading the layout data from the first image forming member (RFID data reading means [0027] reads the image data which can include layout data), wherein: the image reading unit reads the images formed on the first image forming member (the image reading unit of claim 7 has the inherent capability of reading images from the first image forming member); and the image forming unit divides the images read from the first image forming member in accordance with the read layout data and forms the divided images on one of another first image forming member and a single second image

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forming member (The control circuit 29 is inherently capable to control the printing unit 11 to print an image based on the command from PC 39, which can include a program instructions that can divide the image in accordance with a given read data [0081]).

With regards to **claim 9**, an image forming apparatus comprising: an image reading unit for reading images, which are printed on originals, respectively, to form image data each indicating the read images; an image forming unit for forming the read images on a single first image forming member; and a data writing unit for writing total number data indicating total number of the images formed on the single first image forming member into the first image forming member (the same system as claim 1 wherein the data writing unit is further for writing total number data indicating total number of the images. But the copy machine in FIG. 2 is inherently capable of writing total number of images formed on printing paper).

With regards to **claim 10**, which further limits claim 9, comprising: a data reading unit for reading the total number data from the first image forming member (RFID data reading means [0027] has the inherent capability of reading any data from the printing paper), wherein: the image reading unit reads the images formed on the first image forming member (same as claim 8 image forming unit); and the image forming unit divides the images read from the first image forming member in accordance with the read total number data and forms the divided images on one of another first image forming member and a single second image forming member (same as claim 8 image forming unit divides the images read from the first image forming member in accordance with the read total number data. The type of data whether the layout data or total

number data can be provided by PC 39 in FIG. 5. And the control circuit 29 in FIG. 5 controls the printing unit 11 to print an image in accordance with the data provided. The control circuit 29 has the inherent capability of dividing the images).

With regards to **claim 11**, an image forming apparatus comprising: an image reading unit for reading images, which are printed on originals, respectively, to form image data each indicating the read images; an image forming unit for forming the read images on a single first image forming member; and a data writing unit for writing size data indicating sizes of the originals whose images are formed on the single first image forming member into the first image forming member (the same apparatus as claim 1 data writing unit writes data where the data is an original size data from the original paper. a second reader-writer 16 and a third reader-writer 17 are provided to record the data (RFID data) in the RFID tag [0071]. And the data (RFID data) can be any data including an original size data from the original paper).

With regards to **claim 12**, which further limits claim 11, comprising: a data reading unit for reading the size data from the first image forming member (same as claim 4 data reading unit); and a forming member selection unit for selecting an image forming member having size corresponding to the read size data (control circuit 29 in FIG. 5 [0083]), wherein: the image reading unit reads the images formed on the first image forming member (same as claim 8 image reading unit); and the image forming unit forms at least part of the read images on the selected image forming member.

With regards to **claim 13**, an image forming apparatus comprising: an image reading unit for reading images, which are printed on originals, respectively, to form

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image data each indicating the read images (the same system as claim 1); an image forming unit for changing sizes of the read images in a predetermined magnification to form the changed image on a first image forming member (the control circuit 29 in FIG. 5 controls the printing unit 11 to print an image in accordance with the data provided. The control circuit 29 has the inherent capability of changing the sizes); and a data writing unit for writing magnification data indicating the predetermined magnification into the first image forming member (a second reader-writer 16 and a third reader-writer 17 are provided to record the data (RFID data) in the RFID tag [0071]. And the data (RFID data) can be any data including magnification data).

With regards to **claim 14**, which further limits claim 13, comprising: a data reading unit for reading the magnification data from the first image forming member (a first reader-writer 15 is provided to read the data (RFID data) in the RFID tag [0071]. And the data (RFID data) can be any data including magnification data) wherein: the image reading unit reads the images formed on the first image forming member (same as claim 8 image reading unit); and the image forming unit changes the images read from the first image forming member in accordance with the read magnification data to form changed images on one of another first image forming member and a single second image forming member (same rationale as claim 13 image forming unit).

With regards to **claim 15**, an image forming member on which at least one image displayed on at least one original is to be formed, comprising: a data storage unit for receiving and storing image data of the at least one image displayed on the at least one original; and a data supply unit for supplying the stored image data to an external (The

sheet of printing paper 13 has an RFID tag 14 has a data storage unit and data supply unit. See abstract).

With regards to **claim 16**, (the apparatus as claimed in claim 1 and claim 3 inherently imply the method as claimed) an image forming method comprising: reading images, which are printed on originals, respectively, to form image data each indicating the read images (an image reading unit of claim 1 and claim 3); forming the read images on the single first image forming member (an image forming unit of claim 1 and claim 3); and writing the image data indicating the images formed on the single first image forming member into the first image forming member (a data reading unit of claim 1 and claim 3).

With regards to **claim 17**, a program making a computer execute a process comprising: reading images, which are printed on originals, respectively, to form image data each indicating the read images; forming the read images on the single first image forming member; and writing the image data indicating the images formed on the single first image forming member into the first image forming member (claim 17 is a computer program performing the operation the steps of claim 16 using the apparatus of claim 1. Using a computer program to perform these kinds of tasks is well known in the art. The PC 39 in FIG. 5 can be programmed to perform these tasks).

Conclusion

7. The prior art made of record and not relied upon is considered to applicant's disclosure.

Minami et al. (US Patent 7,048,194) teaches a printing paper that set in the printer and used for printing. The printing paper has memory element that stores printing information used for printing such as paper size, paper direction, and paper type.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mesfin Getaneh whose telephone number is (571) 270-3752. The examiner can normally be reached on 8:00AM-5:00PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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